

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 1, 31-38, 40, 41, 43, 44, 46, 47, and 49 are pending. Claims 1, 40, 41, 43, 44, 46, 47, and 49 are amended, and Claims 39, 42, 45, and 48 are cancelled without prejudice or disclaimer. No new matter is introduced.¹

Claims 1 and 31-49 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

The rejection of Claims 1 and 31-49 is traversed.

In rejecting Claims 1 and 31-49, the outstanding Office Action asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the Office Action states at page 2 that:

- (1) the recited "back face" in claims 1 and 44 and their dependent claims;
- (2) the recited "bottom face" in claims 1 and 44 and their dependent claims;
- (3) the recited "front face" in claims 1 and 44 and their dependent claims;
- (4) the negative limitation "wherein said tilt member contact body is not a plate wrapped around said tilt member support body" in claims 39 and 45 (see, e.g., MPEP 2173.05(i));

¹ Support for amended Claims 1 and 44 can be found at least in Claims 42 and 48 as previously filed, for example.

(5) the recited "support face" in claims 40-43 and 46-49;
(6) the recited "a front face" in claims 41 and 47; and
(7) the recited "a top face" in claims 42 and 48
...is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to Item (4), Claims 39 and 45 are canceled without prejudice or disclaimer. Thus, the rejection of Claims 39 and 45 is moot.

With respect to Items (1)-(3) and (5)-(7), the claimed "back face," "bottom face," "front face," "support face," and "top face" are fully supported at least by the disclosure as originally filed. MPEP 2163.06 states that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." (Emphasis added.) Indeed, M.P.E.P. 2162(I) states that "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.

Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)." As further noted in M.P.E.P. § 2163(II)(3)(a):

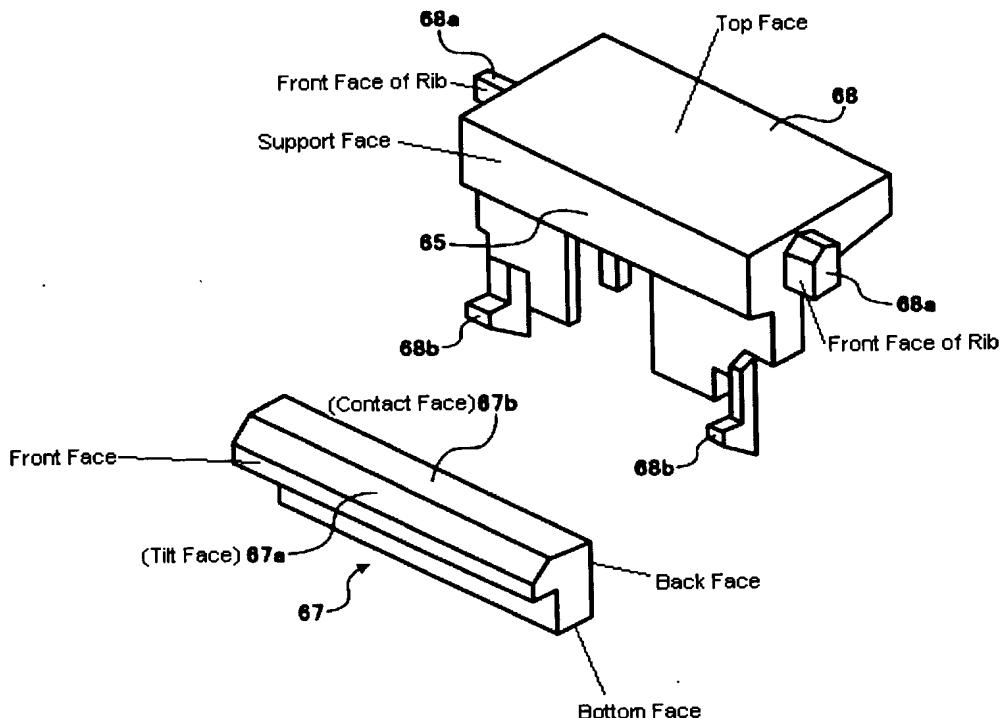
An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 ("drawings alone may provide a 'written description' of an invention as required by Sec. 112*"); *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant's specification provided sufficient written

descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.")...

... See *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966 ("written description" requirement may be satisfied by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention").

In this case, Figures 4, 7, and 8 of the disclosure as originally filed fully satisfy the written description requirement of 35 U.S.C. § 112, first paragraph as it pertains to the claimed "back face," "bottom face," "front face," "support face," and "top face." As an example, Figure 8 is annotated and reproduced below.

FIG. 8



The annotations on Figure 8 illustrate where the corresponding structure in the claims finds support in the originally filed disclosure. However, Applicant notes that the claimed invention is not limited to the example embodiment illustrated in Figures 4, 7, and 8, but that the above annotations are solely intended to demonstrate that Applicant had possession of the claimed invention without precluding any equivalents thereof.

Turning now to Items (1)-(3) in the outstanding Office Action, the recitation of “back face,” “bottom face,” and “front face” in Claims 1, 44 and the claims depending therefrom, Claims 1 and 44 each recite, *inter alia*:

...a tilt member opposing the sheet feed roller, said tilt member including
a tilt member contact body including
a contact face in direct contact with the sheet feed roller,
a tilt face configured to be in contact with an edge of the uppermost sheet,
a back face,
a bottom face, and
a front face, the contact face extending from the back face to the tilt face, the tilt face extending from the contact face to the front face, the back face extending from the contact face to the bottom face ...

As can be seen in Figure 8 of the disclosure as originally filed, an annotated version of which is reproduced above, each of the claimed “back face,” “bottom face,” and “front face” were in Applicant’s possession at the time of the invention.

With respect to Item (5), the recitation of “support face” in Claims 40-43 and 46-49, Claim 40 recites, for example, that the tilt member support body includes a support face and two hooks that extend away from said tilt member support body in a direction that is substantially parallel to the support face. As can be seen in the above annotated version of

Figure 8 the claimed “support face” was in Applicant’s possession at the time of the invention.

With respect to Item (6), the recitation of “a front face” in claims 41 and 47, Claim 41 recites, for example, that the tilt member support body includes a support face and *two ribs that each include a front face* that extends substantially parallel to the support face. As can be seen in the above annotated version of Figure 8 the claimed “a front face” was in Applicant’s possession at the time of the invention.

With respect to Item (7), the recitation of “a top face” in claims 42 and 48, Claim 42 recites, for example, that the tilt member support body includes a support face and *a top face* that extends substantially perpendicular to the support face. As can be seen in the above annotated version of Figure 8 the claimed “top face” was in Applicant’s possession at the time of the invention.

In an Advisory Action dated July 31, 2008, the PTO clarified that the rejection under 35 U.S.C. § 112, first paragraph is based on the recitation in Claims 1 and 44 of “a back face, a bottom face, and a front face ... a thickness of the tilt member contact body that extends from the back face to the front face is less than a height of the tilt member contact body that extends from the contact face to the bottom face.” In this regard, the Advisory Action states:

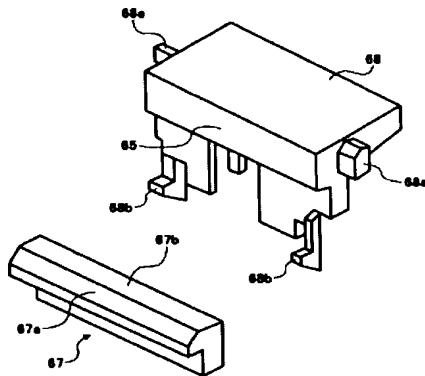
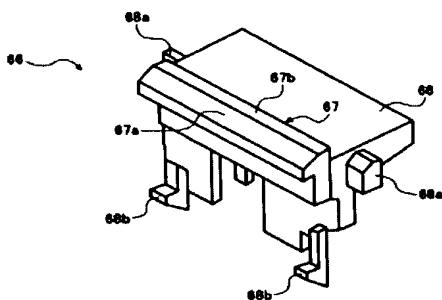
...no part of the instant application discloses that any of the drawings of the instant application are drawn to scale. Accordingly, applicant cannot rely on any of the drawings of the instant application to disclose the size of the thickness of the tilt member relative to the height of the tilt member, as currently claimed in claims 1 and 44 and their dependent claims.

Amended Claims 1 and 44 each delete “a thickness of the tilt member contact body that extends from the back face to the front face is less than a height of the tilt member contact body that extends from the contact face to the bottom face,” from their respective recitations. Accordingly, it is submitted all of the claims fully comply with the written description requirement. It is respectfully requested the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Further, Amended Claims 1 and 44 incorporate subject matter previously recited in Claims 42 and 48, respective. Amended Claims 1 and 44 each recite the tilt member support body includes a support face and a top face that extends substantially perpendicular to the support face, and the back face of the tilt member contact body *directly contacts* the support face of the tilt member support body. This feature is fully supported in the disclosure as originally filed at, for example, Figures 7 and 8, which are reproduced below.

FIG. 8

FIG. 7



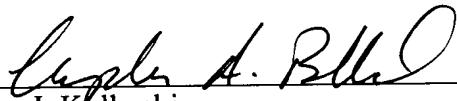
Application Serial No. 10/611,901
Reply to Office Action of April 25, 2008, and
the Advisory Action dated July 31, 2008

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance. A Notice of Allowance for Claims 1, 31-38, 40, 41, 43, 44, 46, 47, and 49 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, he or she is encouraged to contact Applicant's undersigned representative by the below listed telephone number.

Respectfully submitted,

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